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EXAMINER

GRAHAM, CHANTEL LORAN

ART UNIT	PAPER NUMBER
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1775

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12/20/2010

ELECTRONIC

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Response to Amendment

Arguments by applicant have been considered; however, they are not persuasive for the reasons set forth in the prior Office Action. Additionally, the amendments to claims 16, 25, 30, 36 and 37 filed on 12/8/2010 are insufficient to overcome the rejection of claims 16-19, 22, 24-34 and 36-37 based upon the reference applied under 35 USC 103 as set forth in the previous office action because: BLANCHARD teaches an organic colloidal dispersion comprising: particles of at least a compound based on at least a rare earth, with at least one element (E) **(element (E)—para 34-35 and EXAMPLE 6)**, at least an acid, which is an amphiphilic acid (para 41), and at least a diluent, such as Cryo-TEM which is a preservative **(antioxidant)**, characterized in that at least 90% of the particles are monocrystalline. The invention also concerns the method for preparing said dispersion and its use as an additive to diesel fuel for internal combustion engines (abstract), and conventional fuel (para 102). BLANCHARD also teaches that the rare earth can be selected from **cerium**, lanthanum, yttrium, neodymium, gadolinium and praseodymium (para 30); and that the element (E) can be iron **(wherein the rare earth compound is cerium and the element E is iron) (para 34-35 and EXAMPLE 6)**. WAKEFIELD teaches an additive comprising a rare earth compound, a metal (abstract); and **an antioxidant that is phenolic an alkylphenol such as 2,6-di-tert-butylphenol** (paragraph 53); which can be in an organic solvent **(paragraph 37)**; and an organic carboxylic acid **(paragraph 27)** which is an amphiphilic acid. WAKEFIELD also teaches that the **metal can be iron** (para 8 and see also claim 4), and the **rare earth element is cerium** (para 8). Thus the Examiner is of the position that results presented are not seen to be unexpected since element (E) or the metal in the prior art is also iron, and the prior art are seen to be functioning as expected.

In addition, Applicant argues: “*First of all, Applicant maintains that there is no teaching in the art as applied that the presence of the antioxidant in the dispersion enhances the stability of the particles in the fuel, and the inventors found that the claimed dispersions exhibited superior properties. Such evidence of unobvious or unexpected advantageous properties, such as superiority in a property the claimed compound shares with the prior art, can rebut prima facie obviousness. MPEP 716.02(a).11.*” The Examiner respectfully disagrees for at least the reasons set forth above. Additionally, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (motivation question arises in the context of the general problem confronting the inventor rather than the specific problem solved by the invention); *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323, 76 USPQ2d 1662, 1685 (Fed. Cir. 2005) (“One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings.”); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (discussed below); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991). Also, “[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.” *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968) Thus Applicant has not established evidence to the contrary or evidence of criticality; therefore the Examiner maintains the rejection of record.

/CHANTEL GRAHAM/
Examiner, Art Unit 1775

/Ellen M McAvoy/
Primary Examiner, Art Unit 1771